

REMARKS

Status of Claims

Claims 1 and 2 have been amended. Support for the amendments can be found throughout the specification and claims as filed, e.g., at page 74, lines 6-9. No new matter has been added.

Claims 3-20 have been cancelled without prejudice or disclaimer of the subject matter thereof.

The amendment and/or cancellation of claims is without prejudice or disclaimer of the subject matter thereof and was done solely to expedite prosecution of the present application. Applicants reserve the right to pursue the original subject matter of this application in a later-filed application claiming benefit of the instant application, including without prejudice to any determination of equivalents of the claimed subject matter.

Now pending are claims 1-2. No new matter has been added.

Applicants request reconsideration in view of the amendments and remarks presented herein.

Rejections under 35 U.S.C. §112, second paragraph

Claims 1 and 2 stand rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite. This rejection is traversed.

In the Office Action, the Examiner stated that the phrases "optionally substituted hydroxyl", "optionally substituted thiol", and "optionally substituted sulfonyl" are indefinite. This rejection is traversed. However, without agreeing with the rejection, these terms have been deleted from the claim language. Applicants submit that the amended claims are not indefinite.

In the Office Action, the Examiner also stated that the phrase "derivative" is indefinite. This rejection is traversed. However, without agreeing with the rejection, this language has been deleted from the claims. Applicants submit that the amended claims are not indefinite.

Reconsideration and withdrawal of the rejection is proper and the same is requested.

Rejection under 35 U.S.C. §102(a) and (e)

Claims 1 and 2 stand rejected under 35 U.S.C. §102(a) and (e) as being allegedly anticipated by Shiraishi et al., WO2003/14105 or US20040259876. This rejection is traversed.

As the Examiner will appreciate, the present claims are directed to methods for preparing an optically active compound. In contrast, the Shiraishi reference discloses racemic compounds and methods for making them. A racemic mixture (e.g., as disclosed in the Shiraishi reference) is not the same as an optically active compound (e.g., as claimed in pending claims 1-2). Thus, the disclosure of the Shiraishi reference does not teach or suggest a method for preparing an optically active compound as presently claimed.

Moreover, a method for making racemic compound may not be applicable for preparing an optically active compound. When an optically active starting material is used to prepare an optically active product, racemization of the starting material or the product can occur, resulting in partial or complete loss of optical activity. Thus, a method suitable for preparing a racemic material may not be suitable for preparing an optically active material. Applicants submit that the present claims are not anticipated by, nor rendered obvious by, the Shiraishi reference.

Reconsideration and withdrawal of the rejection is proper and the same is requested.

Rejection under 35 U.S.C. §102(f)

Claims 1 and 2 stand rejected under 35 U.S.C. §102(f). The Office Action states that “[t]here are no common inventors in the instant application.” Applicants understand the Examiner to be referring to the named inventors of the present application and the named inventors of the Shiraishi reference. This rejection is traversed.

A rejection under 35 U.S.C. §102(f) can apply only where the applicant "did not himself invent the subject matter sought to be patented." See, e.g., MPEP 2137. However, as discussed above, the methods presently claimed differ from the methods disclosed in the Shiraishi reference. Whether or not there are inventors in common between the present application and the Shiraishi reference is therefore not relevant.

Reconsideration and withdrawal of the rejection is proper and the same is requested.

Double Patenting Rejection

Claims 1 and 2 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claim 28 of co-pending application 10/484,762 (the application corresponding to Shiraishi US20040259876 discussed above). This rejection is traversed.

As noted above, the claims of the present application patentably distinguish over the Shirairishi reference. Applicants respectfully contend that the present claims are not rendered obvious by any claim of the Shiraishi application.

Moreover, Applicants note that claim 28 of the Shiraishi application has been cancelled and is no longer pending. Applicants submit that the rejection is therefore moot.

Reconsideration and withdrawal of the rejection is proper and the same is requested.

CONCLUSION

It is believed that all claims are in condition for allowance. Early and favorable consideration of the application is earnestly solicited.

If the Examiner considers that obstacles to allowance still exist, the undersigned invites the Examiner to contact him at the telephone number given below.

In the event that an extension of time is required, the undersigned conditionally requests any necessary extension of time. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Reference No. 68099 (303421), Customer No. 21874.

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Respectfully submitted,

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